

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q77958

Eric MONTFORT, et al.

Appln. No.: 10/687,585

Group Art Unit: 3664

Confirmation No.: 2460

Examiner: Brian J. BROADHEAD

Filed: October 20, 2003

For: A SYSTEM FOR CONTROLLING THE ATTITUDE OF A GEOSTATIONARY
SATELLITE

REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52

MAIL STOP APPEAL - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In the Decision on Appeal dated September 29, 2009, the Board of Patent Appeals and Interferences ("the Board") affirmed the rejection of claims 8, 10, 12 and 13 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,944,761 to Heiberg et al. (hereinafter "Heiberg"); the rejection of claims 4, 6, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Heiberg, and the rejection of claims 5, 7, 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Heiberg in view of U.S. Patent No. 6,089,507 to Parvez et al. (hereinafter "Parvez").

In the Decision on Appeal, the Board concluded that Appellants failed to establish error on the part of the Examiner in rejecting claim 8 under 35 U.S.C. § 102(b) as being anticipated by Heiberg. The Decision on Appeal further states that Appellants failed to establish that the

Examiner erred in rejecting claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Heiberg.

Appellants submit that the Board misapprehended the disclosure of Heiberg and overlooked one of the arguments made in the Appeal Brief for the following reasons.

First, on page 12 of the Decision on Appeal, the Board focuses on the language “*known and constant*” in Heiberg as a basis for inferring that Heiberg inherently teaches “a corrector such that the bandwidth of said loop contains the lowest and most energetic frequencies of the flexible modes,” as recited in claims 4 and 8. The Board cites Heiberg at col. 2, lines 63-64. *See* page 12 of the decision. Indeed, the cited paragraph relates to a description that the frequencies in Heiberg are known and constant. However, Heiberg does not disclose any frequency or bandwidth. Heiberg is silent as to this feature found in Appellant’s claims 4 and 8. The mere assertion that a frequency is known and constant is insufficient to show that specific frequencies or a specific bandwidth, namely a bandwidth which contains the lowest and most energetic frequencies, is inherently disclosed by the reference. As the Board is aware, one cannot establish inherency by probabilities or possibilities. Instead, inherency must necessarily flow from the description in the reference itself. In this instance, there is no indication in the Heiberg reference that the control loop in Heiberg contains the lowest and most energetic frequencies of flexible modes, as recited in claims 4 and 8. The mere possibility that the claimed frequencies might be included in the Heiberg loop, is not enough to establish inherency.

Second, the Board’s Decision on Appeal states at page 12 that “in order to function properly in its bandwidth, Heiberg needs only to make sure that the compensator recognizes frequencies in its bandwidth.” However, this misapprehends the point at issue. The fact that a

reference may recognize frequencies in a bandwidth has nothing to do with the question of whether the frequencies are the lowest and most energetic frequencies, as claimed.

Third, in his concurring opinion, Judge McCarthy notes that “[w]here, as here, an examiner has reason to believe that a prior art structure similar in structural terms to that recited in a claim *necessarily* performs a recited function, the Examiner may shift the burden to the applicant to prove that the recited function is not inherent.” See page 16 of the decision. Judge McCarthy’s statement of the law, *per se*, is correct. However, it presumes a fact that is not in evidence, because Heiberg, does not describe, expressly or inherently, that the frequencies are the lowest and most energetic frequencies, as claimed.

Fourth, as discussed at page 14 of the Appeal Brief, the Markely reference (“Attitude Control System Conceptual Design for Geostationary Operational Environmental Satellite Spacecraft Series”) teaches a bandwidth in which the lowest and most energetic frequencies are avoided. The board has overlooked the fact that Markley is evidence that the use of a bandwidth including the lowest and most energetic frequencies would not have been used by an artisan, and provides evidence a person of ordinary skill in the art would have excluded the lowest and most energetic frequencies from the bandwidth.

For the above reasons, modification of the Decision on Appeal and reversal of the Examiner's rejections are respectfully requested.

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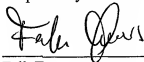
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CUSTOMER NUMBER

Date: November 25, 2009

Respectfully submitted,



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